

REMARKS

Claims 1-6, 11-14, 16-17, 19, and 23-31 are currently pending in the subject application and are presently under consideration. Claims 1, 11-14, 16-17, 19, 23, 26, and 29-31 have been amended, as shown on pages 2-10 of the Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claim 17 Under 35 U.S.C. § 112, Second Paragraph

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as invention. The Official Action dated March 5, 2009, alleges that the claim does not actually recite any structure within the body of the claim. Specifically, it is alleged that “there is no specific structure set forth delineating exactly what accomplishes the steps of the claim . . .” and that it “is unclear if applicant is seeking to claim every possible system that could perform the steps of claim 17, or if applicant is seeking to claim a specific system.”

Advisory Action dated June 16, 2009, alleges without further elaboration or citation to authority that amended claim 17 fails to overcome the instant rejection. Applicants’ representative respectfully disagrees and requests further elaboration and citations to authority in support of these allegations. For example, 35 U.S.C. § 112, second paragraph, requires that the “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” However, the requirement of reciting particular structure within the body of the claim appears to conflate elements of 35 U.S.C. § 101 with 35 U.S.C. § 112 without authoritative support for such a requirement under 35 U.S.C. § 112. As such, it is respectfully submitted that a rejection on this basis is improper and should be withdrawn.

However, claim 17 is believed to recite sufficient structure delineating what accomplishes recited operations to meet this additional requirement, such that claim 17 is believed to be in condition for allowance. In particular, the claim as amended recites *a wireless carrier billing system executing on a computer operative* to perform the recited operations and *a rollover management system*. Thus, the claim is believed to recite sufficient structure delineating what accomplishes the recited operations, such that claim 17 is believed to be in condition for

allowance. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 1-6, 11-14, 16, 19, and 23-31 Under 35 U.S.C. § 101

Claims 1-6, 11-14, 16, 19, and 23-31 stand rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. The Official Action dated March 5, 2009, suggests that a 35 U.S.C. § 101 process is required to be tied to another statutory class (such as a particular apparatus). In particular, it is alleged that claims 1-6, 11-14, 16, 19, and 23-31 “are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing . . .” and that, “although the independent claims recite, ‘executed on one or more computer systems[,]’ they do not actually recite any structure within the body of the claim.”

Advisory Action dated June 16, 2009, alleges without further elaboration or citation to authority that the amended claims fail to overcome the instant rejection. Applicants’ representative respectfully disagrees and submits that such allegations are without basis in fact, and the allegations do not account for the fact that the claims were amended to incorporate sufficient structure within the body of the claim. To reduce the number of issues for consideration in the present application, independent claims 1, 11, 19, 23, 26, and 29 have been amended consistent with the Examiner’s suggestions as previously noted. As a result, it is respectfully submitted that the subject claims meet the requirements for patentability under 35 U.S.C. § 101.

Regarding independent claims 1, 11, 19, 23, 26, and 29, the Federal Circuit has established in *In re Bilski* that inventions such as that claimed by applicants meet the statutory requirements of 35 U.S.C. § 101. 545 F.3d 943 (Fed. Cir. 2008)(*en banc*), *cert. granted*, 556 U.S. __ (June 1, 2009) (No. 08-964).

“A claimed process is surely patent-eligible subject matter under § 101 if: (1) it is tied to a *particular machine or apparatus*, or (2) it *transforms a particular article into a different state or thing*.” *Id.* at 954, (citation omitted). “[T]he electronic transformation of the data itself . . . was sufficient; *the claim was not required to involve any transformation of the underlying physical object that the data represented*.” *Id.* at 96, (discussing the transformation of raw X-ray attenuation data into a particular visual depiction of a

physical object on a display), *citing In re Abele*, 684 F.2d 902 (C.C.P.A. 1982) (emphasis added). “We believe this is faithful to the concern the Supreme Court articulated as the basis for the machine-or-transformation test, namely the prevention of pre-emption of fundamental principles.” *Id.*

Applicants’ representative respectfully submits that the requirements to fulfill the conditions for patentability under 35 U.S.C. § 101 are satisfied. The Federal Circuit in *In re Bilski* established that a process is patent-eligible if it *transforms a particular article into a different state or thing*. In addition, the Federal Circuit allowed that *electronic transformation of the data itself is sufficient* and that *the claim was not required to involve any transformation of the underlying physical object that the data represented*. Moreover, a process that is tied to a *particular machine or apparatus* is also patentable subject matter under 35 U.S.C. § 101.

A “general purpose computer programmed to carry out a particular algorithm creates a ‘new machine’ because *a general purpose computer ‘in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.’*” *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1348 (Fed. Cir. 1999) (discussing the construction of a 35 U.S.C. § 112, paragraph 6 limitation) (emphasis added). “The instructions of the software program in effect ‘create a special purpose machine for carrying out the particular algorithm.’” *WMS Gaming*, 184 F.3d at 1348.

“Although many, or arguably even all, . . . elements recited in claim 15 . . . perform mathematical calculations, . . . *the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for . . . [performing the recited mathematical calculations].*” *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994). “*This is not a disembodied mathematical concept* which may be characterized as an ‘abstract idea,’ *but rather a specific machine* to produce a useful, concrete, and tangible result” *Id.* “Indeed, *claim 15 as written is not ‘so abstract and sweeping’ that it would ‘wholly pre-empt’ the use of any apparatus employing the combination of mathematical calculations recited therein.*” *Id.*, *citing Gottschalk v. Benson*, 409 U.S. 63, 68-72 S.Ct. 253, 255-258 (1972). In any case, a computer, like a rasterizer, is [an] apparatus not mathematics. *Id.* at 1545.

However, while the Federal Circuit in *Bilski* disavows sole use of the *In re Alappat* “useful, concrete, and tangible result” test as insufficient to determine whether a claim is patent-eligible under 35 U.S.C. § 101, 545 F.3d at 991, the Federal Circuit left open the question whether or when recitation of a computer suffices to tie a process claim to a particular machine, slip opinion at 24. According to *WMS Gaming, Inc. v. International Game Technology* and *In re Alappat*, instructions of a software program in effect *create a special purpose machine, or a specific machine, for carrying out a particular algorithm*. The subject claims clearly satisfy the legal standards set forth in *In re Bilski*, *WMS Gaming*, and *In re Alappat*.

Furthermore, according to *Ex parte Dickerson*, claims drawn to a computerized method, which include a step of outputting information from a computer, are statutory subject matter under 35 U.S.C. § 101 according to the *Bilski* machine-or-transformation test, because they are tied to a particular machine or apparatus. No. 2009-001172, Slip op. at 16 (B.P.A.I. July 9, 2009) (explaining that a computerized method claim step of “outputting the solution from the computer system” is sufficient to meet the statutory subject matter requirements of 35 U.S.C. § 101).

Likewise regarding independent claims 1, 11, 19, 23, 26, and 29, the claims recite methods executed on one or more computers comprising at least one computer implemented step. Thus, it is respectfully submitted that the claims as amended meet the statutory subject matter requirements of 35 U.S.C. § 101 for computer-implemented processes as determined in *In re Bilski*, *WMS Gaming*, and *In re Alappat* and as further allowed in *Ex parte Dickerson*.

However, in the Advisory Action dated June 16, 2009, it is suggested that “applicant’s attempt to overcome the 35 USC 101 rejection by adding the phrase, ‘by a computer’ into the claims is insufficient as it is recited in manner that is considered to be extra-added solution that is not needed complete the steps of the method.” *Ex parte Dickerson* counsels otherwise. Compare the step, “outputting the solution from the computer system” of *Ex parte Dickerson* that is more fairly called an “extra-added solution” to that claimed in the subject claims. Note also, that the *Ex parte Dickerson* step is more fairly termed an “extra-added solution” (e.g., “outputting the solution from the computer system”) and was determined on appeal to be sufficient to meet the statutory subject matter requirements of 35 U.S.C. § 101.

Accordingly, assuming *inter alia* that examiner’s concession that amendments to the subject claims are “extra-added solutions,” the logical conclusion under *Ex parte Dickerson* is that the subject claims meet the statutory subject matter requirements of 35 U.S.C. § 101.

Moreover, the contention that the subject amendments create an “extra-added solution that is not needed complete the steps of the method” appears to suggest a more exacting standard for patent subject matter eligibility than what is allowed under *In re Bilski* and *Ex parte Dickerson*. It is respectfully submitted that, when viewed in the framework *In re Bilski* and *Ex parte Dickerson* as described above, the subject claims clearly satisfy the statutory subject matter requirements of 35 U.S.C. § 101. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 1-6, 10-14, 16-17, 19, and 22-31 Under 35 U.S.C. § 103(a)

Claims 1-6, 10-14, 16-17, 19, and 22-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanagan *et al.*, U.S. Patent Application Publication 2001/0056362 (hereinafter, “Hanagan”) in view of “Cingular Offers Rollover Minutes” (hereinafter, “Cingular”), reported August 20, 2002. Without conceding the propriety of, or the motivation for the combination, reconsideration and withdrawal of the rejection is respectfully requested, at least because Hanagan considered alone, or in combination with Cingular, does not disclose or render obvious each and every limitation of applicants’ claimed invention.

To reject claims in an application under § 103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some apparent reason to combine the known elements in the fashion claimed by the patent at issue (e.g., in the references themselves, interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, or in the knowledge generally available to one of ordinary skill in the art. To facilitate review, this analysis should be made explicit. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See M.P.E.P. § 706.02(j). See also *KSR Int'l Co. v. Teleflex, Inc.*, 550 U. S. ___, 04-1350, slip op. at 14 (2007). The reasonable expectation of success must be found in the prior art and not based on applicant’s disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The subject application relates to providing a single calling plan that allows subscribers to share call units between disparate telecommunications systems (e.g., from two or more separate carriers). *See, e.g., [0005], [0007], etc.* A subscriber can order a minute sharing plan whereby ordered minutes may be used for usage on disparate telecommunication carriers. *Id.* For example, ordered minutes may be used for making both wireless and wireline long distance calls from among telecommunications systems operated by separate carriers. In addition, both the wireless and wireline usage minutes can be charged to the same calling plan even though the services are offered by disparate telecommunications carriers. For example, in various embodiments, because both the wireless and wireline usage can be charged to the same call unit sharing plan, the call unit sharing plan can be provisioned and associated revenue can be apportioned and settled between the disparate carriers.

In another non-limiting aspect, the subject application provides for integrated billing and management services, a rollover management system for managing units of call usage that may be “rolled over” in the call unit sharing plan, an integrated ordering system, and an integrated service settlement system that apportions the revenue between disparate telecommunications systems based upon the subscriber’s utilization of the disparate telecommunication services (e.g., the number of calls made using wireless and wireline carriers). *See, e.g., [0010]-[0011], etc.*

In contrast, Hanagan merely describes a system for “convergent” customer care and billing in a single isolated telecommunications provider’s network elements. *See, e.g., [0050]-[0051], [0053], etc.* Thus, while Hanagan describes “convergent” billing for both wireline and wireless services, Hanagan is clearly directed to the context of a telecommunications provider generating “convergent” billing for its own services, rather than disparate wireline and wireless carriers as applicants claim. Thus, Hanagan cannot be said to explicitly or inherently describe each and every limitation of applicants’ claimed invention, nor does the combination render applicants’ claimed invention obvious.

With reference to the above-discussed differences, independent claim 1 recites: *A method of . . . revenue sharing between a wireless telecommunications carrier and a disparate wireline telecommunications carrier . . . comprising: provisioning by a computer a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage at a disparate wireline carrier to one calling plan . . . and settling a revenue associated with the call unit sharing plan between the wireless carrier and the wireline carrier in a single*

billing cycle by apportioning an amount of the revenue related to wireless services during the single billing cycle to the wireless carrier and apportioning an amount of the revenue related to wireline services during the single billing cycle associated to the wireline carrier.

In this regard, Hanagan at least fails to disclose or suggest *provisioning by a computer a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage at a disparate wireline carrier to one calling plan . . . and settling a revenue associated with the call unit sharing plan between the wireless carrier and the wireline carrier*, as recited in claim 1. In contrast, Hanagan limits the application of its system to a *single* telecommunications provider that provides more than one type of service, wherein all services are maintained in a single customer database. *See, e.g., Abstract, [0050]-[0051], [0053], etc.*

Furthermore, Hanagan is silent with respect to sharing of minutes between wireless and wireline services. That is, Hagan fails to disclose or suggest *allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage at a disparate wireline carrier to one calling plan*, as recited in claim 1. In Hanagan, it appears that wireless and wireline usage are charged to separate wireless and wireline calling plans, where bundling different services from a single provider is used to promote volume discounts across services. *See, e.g., [0050], [0077], [0079], [0098], etc.* In other words, Hanagan merely discloses volume services discount rather than sharing of minutes between wireless and wireline services across disparate providers and *apportioning an amount of the revenue related to wireless services during the single billing cycle to the wireless carrier and apportioning an amount of the revenue related to wireline services during the single billing cycle associated to the wireline carrier*, as recited in claim 1. For at least the reasons above, amended independent claim 1 and associated dependent claims patently define over Hanagan.

As a further example, Hanagan fails to explicitly or inherently disclose *provisioning by a computer a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage at a disparate wireline carrier to one calling plan . . . and settling a revenue associated with the call unit sharing plan between the wireless carrier and the wireline carrier*, as recited in amended independent claim 1. Applicants' claimed invention embraces a model of one-customer, many-providers with a *call unit sharing plan between the wireless carrier and the wireline carrier*.

In contrast, Hanagan emphasizes that “convergence” is a key concept of its disclosed systems. *See, e.g., [0009], [0048]-[0050], [0053], FIG. 6., [0098]-[0099], [0101], etc.* Central to this key concept of “convergence” is Hanagan’s embrace of a one-customer, one-provider model, where the one provider creates one bill for all of its services. *See, e.g., [0050], etc.* For example, as Hanagan describes, “[c]onvergence enables a system to be the single customer care and billing system for any telecommunications provider.” *Id.* “All services are maintained in a single customer database, proving a single customer view to CSRs.” *Id.* “The key here is that the bill is truly converged, not simply produced by consolidating the output of multiple systems (also known as “consolidated billing” or “electronic stapling”).” *Id.*

Thus, in this context, it could be argued that Hanagan’s focus on “convergence” and Hanagan’s embrace of the one-customer, one-provider model is not only silent on, but also teaches away from applicants’ system realizing a one-customer, many-providers model. Accordingly, for at least this additional reason, amended independent claim 1 and associated dependent claims are believed to be allowable over Hanagan.

Further regarding amended independent claim 1 (and associated dependent claims), the claim recites: *receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period, and rolling over to the subsequent usage period the number of units of call usage that are available for rolling over.* Note that *units of call usage* are recited in the antecedent as *units of wireless usage at a wireless carrier and units of wireline usage at a disparate wireline carrier . . . [in] one calling plan.* Hanagan fails to disclose these aspects of applicants’ claimed invention as well. Indeed, it is conceded that Hanagan fails to explicitly or inherently describe these limitations as claimed. Thus, for at least these additional reasons, independent claim 1 (and associated dependent claims) are believed to be allowable over Hanagan.

Cingular is cited to supply these missing limitations and for support that applicants’ claimed invention is obvious. *See, e.g.,* Official Action dated March 5, 2009, numbered p. 7. However, Cingular also fails to cure the deficiencies of the root reference, Hanagan. In contrast, Cingular merely reports “Cingular Wireless on Monday became the first major cellular phone company to let customers roll over unused minutes to the following month.” Moreover, no further detail is offered as to the extent of rollover plans or the architecture available to support the decision to “let customers roll over unused minutes.”

Accordingly, Cingular is fairly read to disclose only that Cingular Wireless “let[s] customers roll over unused minutes . . . ,” without giving further technical details on how such rollover is to be accomplished. Furthermore, the context of the report only suggests the possibility of rollover of wireless minutes. In other words, Cingular reports the possibility of rollover of wireless minutes, rather than *rolling over to the subsequent usage period the number of units of call usage that are available for rolling over*, where *units of call usage* are recited in the antecedent as *units of wireless usage at a wireless carrier and units of wireline usage at a disparate wireline carrier . . . [in] one calling plan*. Thus, it is respectfully submitted that neither Hanagan nor Cingular can be said to disclose or suggest applicants’ invention as discussed above with respect to claim 1. It is further submitted that, neither Hanagan nor Cingular independently, or in combination, render applicants’ claimed invention obvious. For at least the reasons above, independent claim 1 and associated dependent claims are believed to be allowable over Hanagan in view of Cingular.

Regarding amended independent claim 11 (and associated dependent claims), the claim recites: *A method for synchronizing services on two disparate services ordering platforms between a first telecommunications services carrier and a second disparate telecommunications services carrier . . . comprising receiving a services order at a first services ordering platform of the first telecommunications services carrier requiring services changes that affect the second disparate telecommunications services carrier, and notifying the second disparate telecommunications services carrier to provide the services order to the second disparate telecommunications services carriers.* Note that applicants disclose that disparate telecommunications systems are also described as separate carriers. *See, e.g., [0005], [0007], etc.*

Hanagan fails to explicitly or inherently disclose these features as claimed, because Hanagan’s Products and Services Manager (PSM) limits itself to allowing a customer to select products, services and price plans offered across markets by one carrier (or *an organization*) using a single consolidated customer database. *See, e.g., Abstract, [0078]-[0080], [0182]-[0186], etc.* Although Hanagan’s Customer Care Manager (CCM) informs the customers about their changes to services ([0168]-[0172]), Hanagan’s CCM fails to explicitly or inherently disclose *notifying the second disparate telecommunications services carrier to provide the services order to the second disparate telecommunications services carriers*. This is evident, because

the system of Hanagan limits itself to customer's products and discount plans across markets at one carrier. *See, e.g., [0143]-[0144], etc.*

In addition, amended independent claim 11 recites: *on a periodic basis, updating a customer affiliate subscriber information database in a businesses services platform the services changes that affect the second disparate telecommunications services carrier, and . . . synchronizing by a computer batch files passed from a subscriber data system of the first telecommunications services carrier to the customer affiliate subscriber information database to ensure the customer affiliate subscriber information database has complete information related to a subscriber to the first telecommunications services carrier and the second disparate telecommunications services carrier.* In contrast to applicants' claimed invention, Hanagan describes a single consolidated database across markets for one carrier. Hanagan fails to explicitly or inherently disclose *synchronizing by a computer batch files passed from a subscriber data system of the first telecommunications services carrier to the customer affiliate subscriber information database to ensure the customer affiliate subscriber information database has complete information related to a subscriber to the first telecommunications services carrier and the second disparate telecommunications services carrier.* Although Hanagan teaches updating and matching changes ([0082], [0094], [0172], [0181], [0192], [0213], [0217], [0219], [0230], [0271], [0272] and [0335]), these updates or changes are understood to be limited to consistency of data within a single ERP database. As a result, Hanagan does not explicitly or inherently disclose these features of applicants' claimed invention, nor does Hanagan render applicants claimed invention obvious. Accordingly, for at least the reasons above, independent claim 11 and associated dependent claims are believed to be allowable over Hanagan.

Furthermore, regarding dependent claim 12, the claim recites: *ensuring that subscriber services at the first telecommunications services carrier are synchronized with subscriber services at the second telecommunications services carrier for any subscriber services affecting both the first and second disparate telecommunications services carriers.* As a result of Hanagan's emphasis of "convergence" and its embrace of a one-customer, one-provider model, where the one provider creates one bill for all of its services, Hanagan is further silent regarding this feature of applicants' claimed invention. For at least this additional reason, dependent claim 12 is believed to be allowable over Hanagan.

Additionally, regarding dependent claim 14, the claim recites: *when a services change is made at the first telecommunications services carrier affecting the second telecommunications services carrier without making a required responsive services change at the second disparate telecommunications services carrier, notifying the second disparate telecommunications carrier of the services change at the first telecommunications services carrier.* As described above regarding dependent claim 12, Hanagan cannot be said to disclose or suggest *notifying the second disparate telecommunications carrier of the services change at the first telecommunications services carrier*, where Hanagan fails to contemplate the synchronization of subscriber services at disparate carriers. The rejection of dependent claim 14 in view of Hanagan should be withdrawn for at least this additional reason.

Moreover, regarding dependent claim 16, the claim recites: *sending an integrated fulfillment notification to any subscriber making services changes with either the first telecommunications services carrier or the second telecommunications services carrier where the services changes affect both the first telecommunications services carrier and the second telecommunications services carrier.* Although Hanagan's CCM informs the customers of any changes in their services across markets within one carrier, Hanagan does not explicitly or inherently disclose these features of applicants' claimed invention, nor does Hanagan render applicants claimed invention obvious. For at least these additional reasons, dependent claim 16 is believed to be allowable over Hanagan.

Regarding amended independent claim 17, the claim recites: *A system for . . . revenue sharing between a wireless telecommunications carrier and a disparate wireline telecommunications carrier, comprising a wireless carrier billing system executing on a computer operative to receive wireless call usage related to wireless calls made via the wireless carrier; to route the wireless call usage to a call usage rating platform at the wireline carrier; the call usage rating platform at the wireline carrier operative to receive wireline call usage related to wireline calls made via the wireline carrier; to charge any of the wireless or wireline call usage to a subscriber call unit sharing plan when any of the wireless or wireline call usage requires a billing charge; to route rated call usage information for all wireless and wireline call usage requiring billing under the subscriber call unit sharing plan to a wireline carrier billing system; a rollover management system operative to generate*

a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; to roll over to the subsequent usage period the number of units of call usage that are available for rolling over and the wireline carrier billing system operative to prepare a single periodic bill showing charges to the subscriber call unit sharing plan related to the wireless and wireline call usage charged to the call unit sharing plan; to indicate the number of units of call usage that have been rolled over to the subsequent usage period; and to settle a revenue associated with the single periodic bill between the wireless carrier and the wireline carrier by apportioning an amount of the revenue related to wireless services during a billing cycle associated with the single periodic bill to the wireless carrier and apportioning an amount of the revenue related to wireline services during the billing cycle associated with the single periodic bill to the wireline carrier.

As noted *supra* regarding independent claim 1, Hanagan fails to explicitly or inherently describe these features as applicants claim. Moreover, Cingular fails to cure the aforementioned deficiencies of the root reference, Hanagan, as further described above. Thus, it is respectfully submitted that neither Hanagan nor Cingular explicitly or inherently describe applicants' invention as claimed. It is further submitted that, neither Hanagan nor Cingular independently, or in combination, render applicants' claimed invention obvious. For at least the reasons above, independent claim 17 is believed to be allowable over Hanagan in view of Cingular.

Regarding amended independent claim 19 (and dependent claim 31), independent claim 19 recites: *A method of . . . revenue sharing between a disparate wireless telecommunications carrier and a wireline telecommunications carrier executed on one or more computers, comprising: provisioning a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage at a disparate wireline carrier to one calling plan; . . . routing the wireless usage to the wireline usage rating platform; rating the wireless and wireline usage at the wireline usage rating platform to determine whether any of the wireless or wireline usage must be charged to the call unit sharing plan; . . . receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over; preparing a single periodic bill showing charges to the call unit sharing plan related to the wireless and wireline usage charged to the call unit sharing plan and the number of units of call usage that have been rolled over to the*

subsequent usage period; settling a revenue associated with the single periodic bill between the wireless carrier and the wireline carrier by apportioning an amount of the revenue associated with wireless services during a billing cycle associated with the single periodic bill to the wireless carrier; and apportioning an amount of the revenue associated with wireline services during the billing cycle related to the single periodic bill to the wireline carrier.

Additionally, dependent claim 31 recites: *when any of the wireless usage comprises a wireless call from a wireless phone of a user to a wireline home phone of the user, designating the wireless or wireline usage related to the wireless call as requiring no charge.*

As noted *supra* regarding independent claim 1, Hanagan fails to explicitly or inherently describe these features as applicants claim. Moreover, Cingular fails to cure the aforementioned deficiencies of the root reference, Hanagan, as further described above. Thus, it is respectfully submitted that neither Hanagan nor Cingular explicitly or inherently describe applicants' invention as claimed. It is further submitted that, neither Hanagan nor Cingular independently, or in combination, render applicants' claimed invention obvious. For at least the reasons above, independent claim 19 and associated dependent claim 31 are believed to be allowable over Hanagan in view of Cingular.

Regarding amended independent claim 23 (and associated dependent claims), the claim recites: *A method of integrating billing management between a plurality of carriers' telecommunications services systems executed on one or more computers, comprising: receiving first call usage associated with calls transacted via a first services system; receiving second call usage related to calls transacted via a second services system; routing the first call usage and the second call usage to one or more call usage rating platforms; determining in a computer billing information related to each of the first and second call usages; routing billing information related to each of the first and second call usages to a billing system; receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over; and preparing a single periodic bill showing charges related to the first and second call usages and the number of units of call usage that have been rolled over to the subsequent usage period.*

As noted *supra* regarding independent claim 1, Hanagan fails to explicitly or inherently describe these features as applicants claim. Moreover, Cingular fails to cure the aforementioned

deficiencies of the root reference, Hanagan, as further described above. Thus, it is respectfully submitted that neither Hanagan nor Cingular explicitly or inherently describe applicants' invention as claimed. It is further submitted that, neither Hanagan nor Cingular independently, or in combination, render applicants' claimed invention obvious. For at least the reasons above, independent claim 23 and associated dependent claims are believed to be allowable over Hanagan in view of Cingular.

Regarding amended independent claim 26 (and associated dependent claims), the claim recites: *A method of integrating billing and services management between a wireless telecommunications carrier and a disparate wireline telecommunications carrier executed on one or more computers, comprising: provisioning by a computer a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage at a disparate wireline carrier to one calling plan; receiving wireless usage at the wireless carrier; receiving wireline usage at a wireline usage rating platform; receiving the wireless usage at the wireline usage rating platform; receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over and when any of the wireless or wireline usage requires a billing charge, charging any of the wireless or wireline usage to the call unit sharing plan.*

As described *supra* regarding independent claim 1, Hanagan fails to explicitly or inherently describe these features as applicants claim. Moreover, Cingular fails to cure the aforementioned deficiencies of the root reference, Hanagan, as further described above. Thus, it is respectfully submitted that neither Hanagan nor Cingular explicitly or inherently describe applicants' invention as claimed. It is further submitted that, neither Hanagan nor Cingular independently, or in combination, render applicants' claimed invention obvious. For at least the reasons above, independent claim 26 and associated dependent claims are believed to be allowable over Hanagan in view of Cingular.

Regarding amended independent claim 29, the claim recites: *A method of integrating billing and services management between a wireless telecommunications carrier and a disparate wireline telecommunications carrier executed on one or more computers, comprising: provisioning by a computer a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage at a wireline carrier to one calling plan;*

receiving wireline call usage at a wireline rating platform; receiving wireless call usage at a wireline rating platform; when any of the wireless or wireline call usage requires a billing charge, charging the any of the wireless or wireline call usage requiring a billing charge to the call unit sharing plan; receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over and preparing a single periodic bill showing charges to the call unit sharing plan related to the wireless and wireline call usage charged to the call unit sharing plan and the number of units of call usage that have been rolled over to the subsequent usage period.

As noted *supra* regarding independent claim 1, Hanagan fails to explicitly or inherently describe these features as applicants claim. Moreover, Cingular fails to cure the aforementioned deficiencies of the root reference, Hanagan, as further described above. Thus, it is respectfully submitted that neither Hanagan nor Cingular explicitly or inherently describe applicants' invention as claimed. It is further submitted that, neither Hanagan nor Cingular independently, or in combination, render applicants' claimed invention obvious. For at least the reasons above, independent claim 29 is believed to be allowable over Hanagan in view of Cingular.

Advisory Action dated June 16, 2009, in partial response to arguments presented above, contends that "the recitation 'revenue sharing' has not been given patentable weight because the recitation occurs in the preamble . . ." and alleges that "it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone." Without conceding the propriety of these contentions as general propositions, it is respectfully submitted that these contentions do not address the arguments made in support of patentability, and which arguments focus on the recited elements in the body of the subject claims, which facilitate the revenue sharing mentioned in the preamble. Accordingly, while recitations in the preamble may be properly denied patentable weight in some circumstances, it is respectfully submitted that the subject claims are believed to be allowable over Hanagan in view of Cingular, on the bases of the limitations recited in the body of the claims, rather than for the recitations in the preamble alone, for at least the reasons above.

Further regarding independent claims 1, 11, 17, 19, 23, 26, and 29 (and associated dependent claims), it is conceded that Hanagan fails to explicitly or inherently describe the

recited methods as being “between a wireless telecommunications carrier and a disparate wireline telecommunications carrier.” *See* Official Action dated March, 5, 2009, beginning at numbered pp. 6, 9, 11, 14, 16, 19, and 21. Applicants’ agree and respectfully submit that the subject claims are allowable over Hanagan for at least this reason.

However, it is further contended that carrying out the methods as recited (“between a wireless telecommunications carrier and a disparate wireline telecommunications carrier”) is not a patently distinct function from Hanagan’s disclosed techniques, where billing from one single provider is “converged” among all the single provider’s services. *Id.* In support of this contention, it is suggested that “it is unclear how the structure used to perform the actions of the method with one company would differ from the structure used to perform the actions of the method with two different companies.” *Id.*

Applicants’ representative respectfully disagrees with these contentions and submits that the steps recited in the subject claims are patentably distinct in view of Hanagan. As best can be understood, these contentions are meant to suggest that, because the subject matter of applicants’ claimed invention is similar in context of use to Hanagan’s disclosed system, the underlying structures must also be similar (or at least not patentably distinct). Applicants’ representative respectfully disagrees with such a suggestion.

In further support of this contention (that applicants’ claimed steps involving disparate carriers are not patentably distinct), *Ex parte Pfeiffer*, 135 USPQ 31 (Bd. Apps. 1961), is cited for the proposition that applicants claimed subject matter “amount to the mere claiming of a use of a particular structure. . .” in a method claim. *Id.* Applicants’ representative respectfully disagrees with this contention. It is respectfully submitted that the subject claims and Hanagan’s disclosure are not the same, but for “mere claiming of a use of a particular structure.” Rather, the structural differences (e.g., claimed steps involving disparate carriers versus Hanagan’s converged billing within a single carrier) are external to the subject invention, and the recited steps are arranged to accomplish a wholly different purpose from that disclosed in Hanagan. As a result, applicants’ representative respectfully submits that these arguments are misplaced, and that the rejections relying on these arguments should be withdrawn.

It is respectfully submitted that these suggestions and contentions argue around and avoid the proper inquiry, which is whether the recited steps are patentably distinguishable from the prior art, or whether any identified distinctions are obvious to one having ordinary skill in the art.

The framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 include inquiries [findings of fact] enunciated by the Court as follows:

- (A) Ascertaining the scope and content of the prior art;
- (B) *Ascertaining the differences between the claimed invention and the prior art*; and
- (C) Resolving the level of ordinary skill in the pertinent art. *See, e.g.*, M.P.E.P. 2141 II [R-6], *see also Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) (emphasis added). Factual findings made by Office personnel are the necessary underpinnings to establish obviousness. *See, e.g.*, M.P.E.P. 2141 II [R-6]. “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

It is respectfully submitted that the discussion of allegedly implied similar structure (between the subject claims and Hanagan) does not discharge the Office's duty to ascertain the differences between the claimed invention and the prior art. For example, it is contended that any structure used to accomplish Hanagan's disclosed techniques would be similar (or at least any differences are not clear). *See* Official Action dated March, 5, 2009, beginning at numbered pp. 6, 9, 11, 14, 16, 19, and 21. However, rather than *ascertaining the differences between the claimed invention and the prior art*, and then explaining why any identified differences are obvious, this conclusion recasts Hanagan into something more than it teaches while eliding over the details of *the differences between the claimed invention and the prior art* as well as any reasoning that should be articulated to support the conclusion of obviousness.

For example, as described above, Hanagan paragraph [0050] is cited throughout the Official Action to support the contention that Hanagan discloses the recited features of applicants' claimed invention (which roughly provide a call sharing plan allowing a user to charge wireless usage at a wireless carrier and wireline usage at a disparate wireline carrier to one calling plan and settling revenue associated with the call unit sharing plan between the wireless carrier and the wireline carrier). However, it has been demonstrated (and indeed conceded) that Hanagan fails to disclose these features, as recited in the respective claims. Meanwhile, it is suggested that, because the subject matter of applicants' claimed invention is similar in context of

use to Hanagan's disclosed system, the underlying structures must also be similar (or at least not patentably distinct), or that the recited claims amount to otherwise patentably indistinct method claims with "mere claiming of a use of a particular structure . . ." in a method claim.

However, these contentions fail to *ascertain the differences between the claimed invention and the prior art* and then explain why any identified differences are obvious. Instead, this conclusion elides over the details of *the differences between the claimed invention and the prior art* (e.g., the differences between billing and revenue sharing based on disparate carriers and billing based on a single carrier with multiple services) as well as any reasoning that should be articulated to support the conclusion of obviousness (e.g., why one would be motivated to take Hanagan's system of a single carrier providing multiple services and extend it to share revenue with a disparate carrier). Accordingly, independent claims 1, 11, 17, 19, 23, 26, and 29 (and associated dependent claims) are believed to be allowable over the combination of Hanagan and Cingular for at least these additional reasons.

In addition, regarding independent claims 1, 11, 17, 19, 23, 26, and 29 (and associated dependent claims), it is contended that applicants' claimed invention is obvious, because if "the method of Hanagan . . . is performed for a single company, . . . it could be performed for separate companies. . ." *See* Official Action dated March, 5, 2009, beginning at numbered pp. 7, 9, 11, 14, 17, 20, and 22. In support for this contention, M.P.E.P. 2144.04 V (section B "Making Integral" and section C "Making Separable") is cited for the proposition that the practices of Hanagan for multiple carriers renders applicants' claimed invention obvious. *Id.* Applicants' representative respectfully disagrees.

First, the referenced portions of M.P.E.P. 2144.04 V refer to changes to prior art apparatuses that were deemed obvious, where either an assembly comprising several parts were combined into a single integral piece, or where a single integral piece was designed to use more than one attached, removable component parts. In contrast, with the exception of claim 17 (system claim) applicants' claimed invention recites methods steps that are applied in a context different from Hanagan to achieve a wholly different result. As such, the referenced portions of M.P.E.P. 2144.04 V are inapposite to the present controversy.

Second, it is respectfully submitted that the suggestion that a simple application of Hanagan's system to more than one carrier can produce applicants' claimed invention is false, it mischaracterizes the scope and operation of Hanagan, and it elides over the relevant differences

between Hanagan and applicants' claimed invention. Rather than arriving at applicants' claimed invention, an application of Hanagan to more than one carrier would simply result in Hanagan's system being employed at each carrier, without any function available (as provided by applicants' claimed invention) to share revenue among carriers, for example. As a result, applicants' representative respectfully submits that these arguments are misplaced, and that the rejections relying on these arguments should be withdrawn.

Reconsideration and withdrawal of the rejection of independent claims 1, 11, 17, 19, 23, 26, and 29 (and associated dependent claims) under 35 U.S.C. § 103(a) is respectfully requested in view of the comments above.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [ATTWP278USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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